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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,923	02/05/2002	Laszlo Papai	TCP:104 US	9881

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Howard M. Ellis
Simpson, Simpson & Snyder, PLLC
5555 Main Street
Williamsville, NY 14221

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 01/03/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,923

Applicant(s)

PAPAI, LASZLO

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 01 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This application is before the examiner for consideration.

A. In view of the complexity of the claims as set up these election of species and inventions are made for the record.

B.1. The first independent claim 1 is considered as the main invention in groups of claims (1-4) and (5-11). Claims 2-11 are considered as the secondary embodiments. There are too many patentably different and distinct embodiments as claimed. Claims 1-11 are generic to a plurality of disclosed patentably distinct species comprising (1) many possible 4(N-ethyl-N-hydroxyethyl)-2-methylphenylenediamine containing developers, (2) many possible N,N-bis(2-sulfoethyl)hydroxylamine and its salts, (3) N,N-bis(2-sulfoethyl)hydroxylamine containing compound alone, (4) N,N-bis(2-sulfoethyl)hydroxylamine containing compound and an additional hydroxylamine containing compound, (5) N,N-bis(2-sulfoethyl)hydroxylamine containing compound and two or more additional hydroxylamines, (6) many possible additional hydroxylamine containing compounds, (7) any pH solution, (8) pH solution of 10-12, (9) no solvent, (10) many possible solvents, (11) mono phase, (12) multiphase, (13) many possible compounds in the upper phase, (14) many possible compounds in the lower phase, (15) many possible buffering agents, (16) two phase system, (17) three phase system, (18) solid phase, (19) third phase being solid, (20) second being solid, (21) diphasic with polyhydric alcohol phase and solid phase and (22) many possible solid salts. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search even though this requirement is traversed.

Art Unit: 1752

If applicants elect item (1), (2), (6), (10), (13), (14), (15) or (22) above, they are requested and required to elect a sub-species such as disodium salt of N,N-bis(2-sulfoethyl) hydroxylamine.

2. The first independent claim 12 is considered as the main invention in groups of claims (12-15). Claims 12-15 are considered as the secondary embodiments. There are too many patentably different and distinct embodiments as claimed. Claims 1-11 are generic to a plurality of disclosed patentably distinct species comprising (1) many possible 4(N-ethyl-N-hydroxyethyl)-2-methylphenylenediamine containing developers, (2) many possible N,N-bis(2-sulfoethyl) hydroxylamine and its salts, (3) N,N-bis(2-sulfoethyl) hydroxylamine containing compound alone, (4) N,N-bis(2-sulfoethyl) hydroxylamine containing compound and an additional hydroxylamine containing compound, (5) N,N-bis(2-sulfoethyl) hydroxylamine containing compound and two or more additional hydroxylamines, (6) many possible additional hydroxylamine containing compounds, (7) pH solution of 10-12, (8) many possible base or alkaline agents, (9) many possible solvents, (10) many possible buffering agents, (11) mono phase, (12) multiphase, (13) many possible compounds in the upper phase, (14) many possible compounds in the lower phase, (15) two phase system, (16) not moving solid, (17) three phase system, (18) solid phase, (19) third phase being solid, (20) second being solid, (21) diphasic with polyhydric alcohol phase and solid phase, (22) many possible solid salts and (23) removing solid. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search even though this requirement is traversed. If applicants elect item (1), (2), (6), (8), (9), (10), (13), (14) or (22) above, they are requested and required to elect a sub-species such as disodium salt of N,N-bis(2-sulfoethyl) hydroxylamine.

Art Unit: 1752

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

C. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. The groups of claims (1-4) and (5-11), drawn to a composition (They have not been considered to be patentably different or distinct. Therefore, no restriction has been made. If applicants urge or show otherwise in the next response to this Office action in order for it to be considered timely, a restriction will be made for the record as urges or shown), classified in class 430, subclass 490.

II. Claims 12-15, drawn to a method of making, classified in class 430, subclass 450.

Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process of making a stable color developer containing solution as claimed can be used to made by another and materially different product such as using a different and distinct color developer and/or hydroxylamine containing in the art. Applicants should show or

Art Unit: 1752

provide an evidence to the contrary. In the absence of convincing evidence, the restriction on the record would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status in the art and can support the separate patents as divided by applicants and have no evidence of the record that they are not patentably different or distinct and are the obvious variants under 35 U.S.C. 103 to one having ordinary skill in the art since no separate consideration or search is necessitated or required because a prior art being applied against one invention is sufficient against all of them, restriction for examination purposes as indicated is proper.

D. However a process or method claim is permitted to be rejoined with an elected, considered, searched and allowable material claim provided the process or method claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

E. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

F. Other issues are not now considered until a proper election is made and resolved.

Art Unit: 1752

G. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7172 for regular communications and 703-746-7172 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
02 January 2002

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le